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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/762,530	05/15/2001	Reto Sieber	F 6817	5031
7590 Jordan and Hamburg 122 East 42nd Street New York, NY 10168		01/19/2010	EXAMINER CHANG, VICTOR S	
			ART UNIT 1794	PAPER NUMBER
			MAIL DATE 01/19/2010	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

09/762,530

Applicant(s)

SIEBER ET AL.

Examiner

VICTOR S. CHANG

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11, 16-19, 22-35 and 37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11, 16-19, 22-35 and 37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/ISA/C3)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Introduction

1. Applicants' amendments and remarks filed on 4/27/2009 have been previously entered [see Office action dated 7/23/2009]. Claims 11, 16-19, 22-35 and 37 are active.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. In response to the amendments, the grounds of rejection have been updated as set forth below. Rejections not maintained are withdrawn.

Election/Restrictions

4. Applicants' arguments in the reply, filed 10/26/2009, to the restriction requirement have been carefully considered, and are persuasive. The restriction requirement has been withdrawn. It is noted tat applicants have stated in the reply that "Any adhesive can be applied at any surface area. Bonding strength should be view as a matrix variable, depending on both amount (area) and type of adhesive." [See Remarks page 3]

Rejections Based on Prior Art

5. Claims 11, 16-19, 22-29, 31-35 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marchal [GB 2063710].

Marchal relates to an adhesive tape for fixing a floor covering or carpet to a floor [pp. 1, 11. 5-6]. The adhesive sheet is sticky on both sides. One surface is more powerfully adhesive

than the other side. The different surface adhesive strength affords multiple advantages for the covering in use, and for positioning and removal [pp. 1, ll. 116-130]. Figs. 1-3 illustrate various alternative embodiments to provide the different adhesive strengths at opposite surfaces. Fig. 3 shows an embodiment having a support layer 11 (backing layer), a glue layer 11B, and a less sticky glue layer 11A, which is formed in the form of strips or points, on the opposite surface [pp. 2, ll. 74-75 and 100-104]. The glue layers 11A and 11B cover the entire surface of the support layer. The tape is fixed more firmly to the back of the covering than to the receiving floor surface [pp. 2, ll. 110-115]. The support layer 11 may be a sheet of textile which may or may not be treated to make it impermeable or it may be a continuous sheet made of a synthetic material (polymer film) [pp. 2, ll. 116-119]. The adhesive layer may consist of a weave of intersecting threads on which glue is applied [pp. 2, ll. 31-33].

For claims 11 and 25-28, Since Marchal teaches that the different surface adhesive strength affords multiple advantages for the covering in use, and for positioning and removal, the adhesive is inherently self-adhesive. Regarding the term “substantially planar”, since Marchal’s adhesive tape relates to the same end use for adhering a floor covering to a floor, the surface feature “substantially planar” is obviously provided by practicing the invention of prior art for the same end use, i.e., a generally planar tape adapted for adhering to generally flat floor covering to a generally flat floor. Regarding the terms “first pattern” and “second pattern”, since Marchal teaches that covering the support with strips or points (patterns) of adhesive results in a less sticky glue layer, i.e., the amount of adhesive coverage is result effective in providing different adhesiveness, it would have been an obvious modification to on one of ordinary skill in the art to form similar patterns of adhesive on the opposite surfaces with a different amount of

adhesive coverage (e.g., different strip widths or point sizes), motivated by the desire to provide the required different surface adhesive strengths on the opposite surfaces of the adhesive tape, which is the core of Marchal's invention. Marchal is silent about the minimum width of the sheet. However, a workable width is deemed to be an obvious routine optimization to one of ordinary skill in the art of adhesive tapes for floor covering, motivated by obtaining similar beneficiary effects for the same end use.

For claims 16-19 and 22-24, Marchal is silent about the adhesive strengths and amount of adhesive per unit area of the adhesive layers. However, since Marchal teaches an adhesive tape having different surface adhesive strengths for the same end use (removably adhering a floor covering to a floor), and teaches that the amount of adhesive coverage is result effective in providing different adhesiveness, workable adhesive strengths and amount of adhesive per unit area of the adhesive layers are deemed to be obviously provided by practicing the invention of prior art for the same end use.

For claim 29, Marchal's teaching of fixing a floor covering by an adhesive tape to a wood floor clearly encompasses a floor of parquet [pp. 1, ll. 86].

For claims 31 and 32, since Marchal teaches that the adhesive layer may consist of a weave of intersecting threads (textile or threaded mesh) on which a glue is applied.

For claims 33-35 and 37, absent a clear definition in the specification, the term "adhesive coatings" is interpreted as meaning "adhesive coated layers". Since Marchal's Figs. 1-3 illustrate that the glue layers 11A and 11B cover the entire surface of the support layer, i.e., all the layers are coextensive, the glue layers have equivalent surface areas.

6. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marchal in view of Su [US 5462782].

The teachings of Marchal are again relied upon as set forth above.

For claim 30, Marchal teaches that backing layer 11 may be a continuous sheet made of a synthetic material. Marchal is silent about the synthetic material being polyethylene. However, Su teaches a double sided adhesive tape comprising a backing layer of polyethylene [abstract] to provide for strength to the tape. It would have been obvious to one having ordinary skill in the art to select a polyethylene film to make Marchal's adhesive tape, because the selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination. See MPEP § 2144.07.

7. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marchal in view of Plumly [US 5363579].

The teachings of Marchal are again relied upon as set forth above.

For claim 36, Marchal teaches a double sided adhesive tape for fixing floor covering to floor. One surface is more powerfully adhesive than the other side. The different surface adhesive strength affords multiple advantages for the covering in use, and for positioning and removal. Marchal is silent about forming the differential adhesive strengths by applying adhesives having different adhesive strengths. However, Plumly's invention relates to a floor type advertising apparatus. Fig. 29 shows an embodiment employing a differential adhesive tape to removably hold the transparent layer in place for removably receiving an advertising layer [col. 13, ll. 10-13 and 64]. The differential adhesive tape is a high tack/medium tack double coated film tape. The medium tack side can be secured to a receiving surface and removed a

number of times without leaving a residue [col. 14, ll. 1-8]. It would have been obvious to one of ordinary skill in the art to form Marchal's adhesive tape with the differential adhesives taught by Plumly, because the substitution of a known equivalent material based on its suitability for its intended use supported a *prima facie* obviousness determination. See MPEP § 2144.07.

Response to Arguments

8. Since the 112 rejections have been withdrawn, applicants' arguments in the reply filed 4/27/2009 are moot.

Following are response to the arguments filed 9/17/2008:

Applicants argue at Remarks page 14:

"Marchal, does not disclose the structural limitation reciting that the first and second pressure-sensitive adhesive coating patterns are the same."

However, since Marchal teaches that covering the support with strips or points (patterns) of adhesive results in a less sticky glue layer, i.e., the amount of adhesive coverage is result effective in providing different adhesiveness, it would have been an obvious modification to one of ordinary skill in the art to form similar patterns of adhesive on the opposite surfaces with a different amount of adhesive coverage (e.g., same strip or point pattern, with different strip widths or point sizes), motivated by the desire to provide the required different surface adhesive strengths on the opposite surfaces of the adhesive tape, which is the core of Marchal's invention.

Referring to claims 33-35, applicants argue at page 16:

"The claims specifically refer to the surface areas of the first and second coatings having an equivalent surface area. Moreover, Applicants explained that these claims were added in the previous amendment to distinguish the coatings of the current invention from Marchal."

However, the limitation recited in claims 33-35 are absent from independent claim 11. Further, even it is considered, since Marchal's Figs. 1-3 illustrate that the glue layers 11A and 11B cover the entire surface of the support layer, i.e., all the layers are coextensive, the patterned glue layers (adhesive coatings) have equivalent surface areas.

Applicants argue at pages 16-17:

"Marchal specifically states that "one side of sheet 11 should always have a larger surface area of adhesive than the other side." Marchal page 2, lines 91-93. Thus, Marchal specifically teaches away from a self-adhesive sheet having equivalent surface areas on the top and bottom of the sheet as recited in claims 33-35."

However, Marchal's teaching relates to total surface adhesive coverage which is physically covered by adhesive, not "adhesive coatings", which is interpreted as meaning patterned adhesive coated layers.

Applicants argue at page 17:

"Applicants respectfully traverse the rejections of claims 17, 19, 24 for not providing an evidentiary basis for the rejections and because the prior art fails to include each element as recited in the claims."

However, since Marchal teaches that covering the support with strips or points (patterns) of adhesive results in a less sticky glue layer, i.e., the amount of adhesive coverage is result effective in providing different adhesiveness. Applicants' argument to the contrary is unpersuasive.

Applicants argue at page 18:

"Applicants respectfully traverse the rejections of claims 31 and 32 for not providing a sufficient evidentiary basis for the rejections."

However, since Marchal expressly teaches that the adhesive layer may consist of a weave of intersecting threads (textile or threaded mesh) on which a glue is applied, evidentiary basis has been provided.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VICTOR S. CHANG whose telephone number is (571)272-1474. The examiner can normally be reached on 6:00 am - 4:00 pm, Tuesday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample can be reached on 571-272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Victor S Chang/
Primary Examiner, Art Unit 1794